

REMARKS

Claims 1-22 are pending in the application.

Claims 1-22 have been rejected.

Claims 1, 8-15, and 22 have been amended without adding any new subject matter to the instant application. Unless otherwise specified in the discussion below, Applicants have amended independent claims 1, 8, 15, and 22 in order to provide clarity or to correct informalities. Dependent claims 9-14 have been amended merely to provide proper antecedent support and clarity in view of amendments to their corresponding independent claim 8.

Claims 27-30 have been added to define additional protectable subject matter without adding any new matter to the instant specification.

The present claim amendments and additions find support throughout the specification of the instant application including, for example, in Figure 2 and the discussion in paragraphs [0006], [0018], [0020], [0026], and [0033] in the specification. (The paragraph numbers in the preceding sentence refer to the published version of the instant application—*i.e.*, U.S. Patent App. Pub. No. US2002/0091588.) Applicants submit that the present claim amendments are not intended to narrow the scope of the currently-pending claims. Applicants further assert that the present claim amendments should not be construed as indicating Applicants' acceptance of Examiner's reasons for rejection of various claims in the Office Action.

After present claim amendments and additions, claims 1-22 and 27-30 now remain pending in the application.

Rejection of Claims under 35 U.S.C. § 101

Claims 1-22 stand rejected under 35 U.S.C. §101 as purportedly being directed to non-statutory subject matter. Claims 1-14 and 22 have been rejected as purportedly being directed to software *per se*. On the other hand, claims 15-21 have been rejected as purportedly reciting method steps that “could simply be performed by mental process alone.” *See* Office Action, p.2 (items 1 and 2). Applicants respectfully traverse the rejection of claims 1-22 in view of present claim amendments and following remarks.

Without acceding to the Office Action’s proffered reasons for rejecting claims 1-14 and 22 under 35 U.S.C. § 101, and merely to expedite prosecution of the instant application, Applicants have amended independent claims 1, 8, and 22 to provide structural and functional interrelationships between computer program codes and hardware components which permit the functionality of the program codes to be realized as discussed in more detail under MPEP §2106.01. Independent claims 1 and 22 are now directed to a computer system comprising executable program code, whereas the independent claim 8 is now directed to a data storage medium storing program code. Therefore, Applicants assert that the amended independent claims 1, 8, and 22, and corresponding dependent claims 2-7 and 9-14, now recite statutory subject matter. Hence, withdrawal of rejection of claims 1-14 and 22 under 35 U.S.C. § 101 and allowance of the same is respectfully requested.

With regard to independent claim 15, Applicants respectfully disagree with the Office Action’s contention that independent claim 15 recites method steps that “could simply be performed by mental process alone.” *See* Office Action, p.2 (item-2). In support of their position, Applicants respectfully draw the Examiner’s attention to the claim step “displaying a service provider product catalog to an end user” in claim 15. Applicants assert that the “displaying” step

is more than a mere “mental process” or abstract idea. The display of a product catalog provides a useful, concrete, and tangible result.

In any event, to expedite prosecution of the instant application, Applicants have amended independent claim 15 to now recite a computer-implemented method, *i.e.*, a method whose steps are implemented using a computer to accomplish the claimed functionality. Therefore, Applicants assert that the computer-based implementation of the method steps recited in the amended independent claim 15, and its corresponding dependent claims 16-21, is now directed to statutory subject matter. Hence, withdrawal of rejection of claims 15-21 under 35 U.S.C. § 101 and allowance of the same is respectfully requested.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over U.S. Patent No. 7,333,600 issued to Gilles et al. (“Gilles”), in view of U.S. Patent No. 5,890,175 issued to Wong et al. (“Wong”). Applicants respectfully traverse these rejections in view of present claim amendments and following remarks.

As an initial matter, Applicants observe that although the Office Action mentions 35 U.S.C. §102(e) in item-4 of the present Office Action to reject claims 1-22 (*see* Office Action, p.3), such mention appears to be a typographical error because of the clear citation of 35 U.S.C. § 103(a) in the immediately preceding item-3, and the discussion of rejection of claims 1-22 in items 5 through 11 (pages 3-7 in the Office Action) over a combination of Gilles and Wong. Therefore, in the discussion below, Applicants address patentability of claims 1-22 under 35 U.S.C. § 103(a) only. If Applicants’ understanding of rejection of claims 1-22 under 35 U.S.C. §

103(a) is inaccurate, Applicants respectfully request the Examiner to provide additional details as to how claims 1-22 are rejected under 35 U.S.C. § 102(e).

While not conceding that the cited references qualify as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows, in light of the amendments made hereby. Applicants reserve the right, for example, in a continuing application to establish that the cited references, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

In order for a claim to be rendered unpatentable under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). Thus, when making a determination of obviousness, the focus should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. MPEP § 2141.

Independent claim 1, as amended, recites a computer system containing executable program code, which comprises, *inter alia*:

an end-user ordering module operable to:

display a service provider product catalog to an end user, wherein the service provider catalog comprises one or more service items...;

provide one or more developer defined labels (DDLs) for each of the one or more service items that have a corresponding local product item, wherein each DDL comprises a local specification from the set of local specifications that is missing from the set of service specifications;

determine whether an end-user requested service item relates to a service item type having at least one associated DDL;

if the requested service item relates to a service item type having at least one DDL, prompt the end-user for a value of each additional DDL-specified attribute in connection with creation of the end-user order for the requested service item; and

communicate the end-user order for use in subsequently creating a corresponding inter-provider order; and

the inter-provider ordering module coupled to the end-user ordering module and operable to...automatically map the value [for the additional DDL-specified attribute] from the end-user order to an appropriate field of the inter-provider order.

See Claim 1 (amended).

Applicants respectfully assert that the primary reference of Gilles fails to teach, suggest, recommend, or hint at, at least, a computer system wherein the program code is operable to: (i) provide one or more developer defined labels (DDLs), wherein each DDL comprises a local specification from a set of local specifications that is missing from the set of service specifications; and (ii) prompt the end-user for a value of a DDL-specified attribute in connection with creation of the end-user order for a communication service, as recited more fully in the amended independent claim 1. Applicants respectfully disagree with the Office Action's assertion that these claim limitations are taught in column 9 of Gilles with reference to discussion of Figs. 5 and 6 therein. *See* Office Action, p.4 (item-5).

The Office Action cites Fig. 5 and column 9, lines 20-61 in Gilles as teaching the first limitation of providing one or more DDLs. However, the cited portion of Gilles discusses three types of feature file—a central office feature file 282, a prefix feature file 284, and a prefix cross-reference file 286—that are automatically made available to a reseller by a wholesaler of a communication service for subsequent use in processing customer orders by the reseller. Gilles, col. 9, lines 20-30; col. 7, line 61 – col. 8, line 18. Thus, these feature files are made available to the reseller prior to processing of customer orders. The Office Action equates these feature files

as the DDLs recited in claim 1. *See* Office Action, p.4 (item-5). However, in that case, the cited portion of Gilles fails to teach or suggest that a feature file contains a local specification (or feature value) from a set of local specifications that is missing from the set of service specifications associated with one or more service items in the service provider catalog displayed to the end user, as recited more fully in independent claim 1. This is due, in part, to Gilles not contemplating separate service specifications and local specifications. *See, e.g.*, Office Action, p.5 (admitting the absence of service specifications in Gilles). Without even contemplating the problem addressed by the present Application, Gilles cannot be said to offer a solution to the problem by only providing one type of purported service specification. That is, Gilles cannot provide the claimed missing specifications if there are no service specifications disclosed.

As for the second limitation of prompting an end-user for a value of a DDL-specified attribute, the Office Action cites Gilles Fig. 6 and the discussion in Gilles column 9, lines 62-67 as teaching this limitation. Applicants again fail to find any discussion, teaching, or suggestion of such end-user prompting in the cited portion and figure of Gilles. Gilles's purported feature availability processing focuses on determination of available features in a particular Central Office (CO) of a wholesaler (of telecommunication products or services) as well as determination of switch identification for COs serviced by more than one switch. *See* Gilles, col. 9, lines 62-67. Assuming that a feature file in Gilles is equivalent to a DDL recited in claim 1—as suggested by the Office Action (*see* Office Action, p.4 (item-5)), Applicants observe that instead of prompting an end-user for value of a feature (or other attribute) specified by such feature file, Gilles teaches that the system or the reseller performs the switch selection based on the desired features. *See, e.g.*, Gilles, col. 10, lines 33-37, lines 46-49, and lines 54-57. There is no discussion in the cited portion of Gilles regarding prompting an end-user or customer for feature values in connection with creation of the end-user order. Applicants assert that, in Gilles,

there is no need for such prompting of a customer for feature values because feature information (or feature values) are already made available to the reseller by the wholesaler. *See*, Gilles, col. 9, lines 20-61.

Applicants here observe that although Gilles mentions allowing a customer to assign “a code” to a feature to indicate its “relative importance” (Gilles, col. 10, lines 37-41), such code assignment is distinct from prompting the customer for a value of the feature. The code assignment merely assists the system or the service representative to select the switch that provides the most important features. *See* Gilles, col. 10, lines 33-43. In Gilles, the switch selection rests with the system or the service representative of the reseller, and not with the customer. Also, “switch selection” in Gilles is distinct from obtaining value of a DDL-specified attribute or feature from a customer in the manner recited more fully in amended independent claim 1. Assuming, *arguendo*, that the code assignment by a customer is equivalent to prompting the customer for a feature value (*i.e.*, a value of a DDL-specified attribute as claimed), Gilles still fails to support such assumption because of its failure to teach, suggest, or recommend a feature file (*i.e.*, a DDL) that contains a local specification from a set of local specifications that is missing from the set of service specifications as discussed above.

Gilles’s failure to teach the above-discussed limitations in claim 1 is further understandable in view of its failure to appreciate or recognize the need to complete an inter-provider order (*e.g.*, a customer order to transfer residential telephone service from one provider to another) with minimal customer interaction, so as to make the process less burdensome to the customer. *See, e.g.*, Application, ¶¶ [0006], [0009]. Applicants fail to find any discussion in the cited portions of Gilles related to inter-provider ordering—*i.e.*, transactions between two competing telecommunications service providers, and not between a wholesaler and a reseller (as is the case in Gilles). Hence, Applicants assert that teaching in Gilles is not capable of

suggesting, recommending, or even hinting at the various aspects of inter-provider ordering and ways to improve such ordering using DDLs as discussed in more detail in the instant specification and recited in the pending claims.

Wong also fails to remedy the deficiencies in the teachings in Gilles. The teachings in Wong relate to purported dynamic generation and display of electronic catalogs (*see, e.g.*, Wong, col. 3, lines 23-33) and is primarily cited only against the claim limitation of displaying a service provider catalog to an end user (*see* Office Action, p.5 (item-5)). Even though Wong has been mentioned in rejecting other pending claims, Examiner has not identified any specific portion(s) of Wong and how it is applied in rejecting such claims. *See* Office Action, pp.6-7 (items 6-11). In other words, except for the limited applicability of Wong in purportedly teaching the product catalog display limitation, Wong has not been cited against any other claim limitation. Because of lack of any discussion of communication service ordering or inter-provider ordering in Wong and because of Wong's limited application to the currently pending claims, Applicants assert that Wong also fails to teach, suggest, or recommend a computer system wherein the program code is operable to: (i) provide one or more developer defined labels (DDLs), wherein each DDL comprises a local specification from a set of local specifications that is missing from the set of service specifications; and (ii) prompt the end-user for a value of a DDL-specified attribute in connection with creation of the end-user order for a communication service, as claimed.

Hence, based on the discussion above, Applicants assert that the combination of Gilles and Wong fails to teach, reasonably suggest, or hint at all the limitations in the combination of claim limitations recited in the amended independent claim 1. Thus, Applicants assert that the amended independent claim 1, as a whole, is not rendered obvious under 35 U.S.C. §103(a) by the combination of Gilles and Wong. Without acceding to the Office Action's reasons for rejection of dependent claims and reserving their right to proffer additional evidence of

patentability of dependent claims, when necessary, Applicants assert that the dependent claims 2-7 are also patentable over the combination of Gilles and Wong at least based on their dependence on the allowable independent claim 1.

The other independent claims 8, 15, and 22 have been amended to contain at least the limitations similar to those recited above with respect to claim 1. Therefore, the arguments in favor of patentability of claim 1 over the combination of Gilles and Wong equally apply to the patentability of amended independent claims 8, 15, and 22 under 35 U.S.C. §103(a). Hence, their corresponding dependent claims 9-14 (claim 8) and 16-21 (claim 15) are also allowable over the applied combinations of Gilles and Wong at least based on their dependence on the allowable independent claims 8 and 15.

Therefore, reconsideration and allowance of claims 1-22 is respectfully requested.

New Claims

The present response adds new dependent claims 27-30, each one depending from the corresponding allowable independent claim 1, 8, 15, or 22, and reciting additional protectable subject matter. Applicants assert that the new dependent claims 27-30 are also allowable over the combination of Gilles and Wong at least based on their dependence on the corresponding allowable independent claims 1, 8, 15, and 22.

Furthermore, each of the new dependent claims 27-30 recites additional patentable limitations related to: (i) providing one or more developer defined labels (DDLs) even though determination of a DDL-specified attribute is unnecessary to create an end-user order for a communication service, and (ii) prompting the end-user for a value of a DDL-specified attribute in connection with creation of the end-user order despite lack of necessity of such value for

creating the end-user order. Applicants assert that neither Gilles nor Wong teaches, suggests, or hints at these additional claim limitations. Therefore, Applicants assert that these additional claim limitations allow claims 27 through 30 to be patentable on grounds other than those based on their dependence on the corresponding allowable independent claims 1, 8, 15, and 22. Hence, favorable consideration and allowance of new claims 27-30 is respectfully requested.

CONCLUSION

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicants also hereby authorize that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

/Jonathan N. Geld/

Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
Telephone: (512) 439-5090
Facsimile: (512) 439-5099